(2)

No. 03-1138

Supreme Court, U.S.
FILED
APR 21 2004
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In the Supreme Court of the United States

TURN-KEY-TECH, LLC,

Petitioner,

v.

NATIONAL FILM LABORATORY, INC. (D/B/A CREST NATIONAL OPTICAL MEDIA), MUSIC CITY OPTICAL MEDIA, INC., HOLLYWOOD RECORDS, INC., CONCORD DISC MANUFACTURING CORP., KRAUSS MAFFEI CORPORATION, AND KRAUSS MAFFEI KUNSTSTOFFTECHNIK GMBH,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

This Court has characterized patent claim construction as a "purely legal" undertaking that requires a "sophisticated analysis of the whole document." *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 389, 391 (1996). In the unpublished order resolving the present case, the Federal Circuit unanimously affirmed a summary judgment of noninfringement of a patented process for manufacturing plastic products, finding that the accused process did not use a claimed "guide conduit." The court of appeals identified two express limitations on the "guide conduit" that were not met: the relevant structure in the accused process was not formed by "[s]eparating the mold parts," and did not "lead[] in a direction substantially perpendicular to [an earlier-identified] predetermined direction." In construing the first limitation, however, the court of appeals also referred to a separate claim element requiring that the plastic disc be ejected into the guide conduit.

The question presented is whether this Court should grant certiorari to decide if the Federal Circuit's reference to another claim element violated due process, where

(i) the court of appeals held that the patent was not infringed on an independent basis (the "substantially perpendicular" limitation);

(ii) the "guide conduit" limitations were thoroughly briefed and the relevant facts were undisputed;

(iii) the petitioner correctly urged the court of appeals to treat patent claim construction as an issue of law subject to *de novo* review rather than a mixed issue of law and fact.

RULE 29.6 STATEMENT

Mannesmann Plastics Machinery GmbH owns more than 10 percent of Respondents Krauss Maffei Corporation and Krauss Maffei Kunststofftechnik GmbH. The Walt Disney Company owns more than 10 percent of Respondent Hollywood Records, Inc. LSR Technologies, Inc. is the parent corporation of Respondent National Film Laboratory, Inc. (d/b/a Crest National Optical Media). No other respondent has a parent corporation and no publicly held company owns 10 percent or more of any other respondent's stock.

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BRIEF FOR THE RESPONDENTS IN OPPOSITION

The petition raises an abstract question that is not presented by the unpublished decision below. Petitioner Turn-Key-Tech LLC objects to one aspect of the Federal Circuit's reasoning when it construed a patent claim limitation at issue in this case, but neglects to mention that the court of appeals held the patent not infringed based on *another* unmet claim limitation as well—a ground of noninfringement left untouched by the petition. Review might delay, but could not alter, the Federal Circuit's correct disposition of this case. There is no reason for this Court to intervene simply to psychoanalyze non-dispositive statements in an unpublished opinion.

In addition, the decision below was neither *sua sponte* nor did it address a mixed question of fact and law. The "guide conduit" element containing both limitations was fully briefed in both the court of appeals and the district court. Yet the petition asserts that the Federal Circuit somehow violated due process by bringing a slightly different perspective to its construction of the written patent claims on a record lacking disputed facts. Moreover, the asserted constitutional violation rests on the premise that patent claim construction is a mixed question of fact and law, a premise that this Court rejected in characterizing claim construction as "purely legal" in *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996). Even if this Court were inclined to revisit *Markman* in a proper case, petitioners waived the issue by arguing to the Federal Circuit that claim construction is a matter of law.

The supposed conflict among the circuits is equally illusory. None of the cases cited in the petition involves the common practice among circuit judges of reasoning through to a result on a purely legal issue without hewing to the precise arguments advanced in the briefing. If that near-universal practice were worthy of this Court's attention, its docket would be crowded indeed. Still less does any decision reject the common (indeed necessary) judicial practice of construing the terms of a patent

(or contract, or statute) with reference to the whole. Rather, petitioner tries to manufacture a conflict from cases that address dismissals or summary judgments entered without any warning, much less opportunity to respond, or (in one case) an administrative appellate tribunal's *sua sponte* finding on the purely factual issue of *credibility*. Those decisions raise no conflict with the routine appellate practice criticized here.

The petition should be denied.

STATEMENT

In this litigation, the petitioner asserts infringement of its patent for a method of molding plastic products (U.S. Pat. No. 4,422,998, "the '998 patent"). The claimed method involves injecting liquid plastic into a two-piece mold, and ejecting the molded product into a "guide conduit" that transports the product away from the mold parts.[1] The dispute centered on the later steps of the process described in Claim 1, the only independent claim (Pet. App. 2a-3a (emphasis added)):

> (d) *Separating the two mold parts* by moving, in a direction opposite to the predetermined direction [in which they moved together to form the disc], said mold parts in relation to each other
>
> *to create a* substantially enclosed *guide conduit*
>
> having contours defined by the regions of the parting surface and the internally positional cavity/ies that are exposed subsequent to separation and
>
> *leading in a direction substantially perpendicular to said predetermined direction*;

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[1] Respondents dispute the petition's characterization of the purported invention in the '998 patent as a "new concept" (Pet. 2). No court has yet considered the validity or novelty of that patent.

(e) Ejecting the plastic product into said guide conduit; and

(f) Guiding and transporting the ejected product from between the mold parts through the guide conduit.

Contrary to petitioner's assertions (Pet. 2-3), the '998 patent claims require more than just a mold that does not fully open. Under Claim 1(d) above, the "guide conduit" at a minimum also must be created by "separating the two mold parts," and must "lead[] in a direction perpendicular to" the path along which the mold parts separate. Pet. App. 2a-3a, 5a, 17a-18a.

Proceedings Below. This litigation consolidates infringement and declaratory judgment actions putting in issue whether petitioner Turn-Key's '998 patent is infringed by the use of the "CD-94 mold" made by the Krauss Maffei respondents and used by the others. After briefing and oral argument, the district court issued a *Markman* order interpreting several disputed claim limitations in the patent. Pet. App. 39a-71a.

In that order, the district court construed a number of limitations relating to the "guide conduit" element in Claim 1(d) of the '998 patent. Among other limitations, the court addressed the terms "separating," "to create a substantially enclosed guide conduit," and "leading in a direction substantially perpendicular to said predetermined direction." See Pet. App. 51a-62a. In each case, the district court concluded that there was no need to resort to extrinsic evidence. *Id.* at 41a-69a.

The district court applied its claim construction when it granted respondents' motions for summary judgment of non-infringement. The court found several "fatal flaws" in petitioner's contention that the CD-94 mold contained the claimed "guide conduit." Pet. App. 25a. In particular, the accused structures of the CD-94 mold (i) did not perform a guiding function; (ii) were not formed by parting surfaces and

cavity surfaces; and (iii) were not created by separation of the mold parts. *Id.* at 25a-29a.

The Federal Circuit unanimously affirmed in an unpublished opinion. Pet. App. 1a-8a. Affirmance rested on the same claim element—the "guide conduit"—that was the focus of the parties' arguments in both lower courts. *Id.* at 5a-8a.

The court of appeals rejected the district court's conclusion that the "guide conduit" had to direct the molded material's motion. Pet. App. 4a. Having broadened the claim construction to petitioner's advantage, the court nonetheless held that the CD-94 mold lacked a "guide conduit" because two properties of the "guide conduit" limitation were absent. The accused structure in the CD-94 mold was not created by "[s]eparating the two mold parts" and did not "lead[] in a direction substantially perpendicular to said predetermined direction." *Id.* at 5a. The panel unanimously denied rehearing; petitioner did not seek rehearing en banc. See Pet. App. 72a-73a.

REASONS FOR DENYING THE PETITION

I. THIS CASE DOES NOT PRESENT THE QUESTION WHETHER DUE PROCESS PERMITS AN APPELLATE COURT TO RULE *SUA SPONTE* ON MIXED QUESTIONS OF FACT AND LAW.

The issue of *sua sponte* rulings raised in the petition may have abstract interest, but it is not presented in this case. First, the Federal Circuit affirmed noninfringement of two limitations related to the "guide conduit." Failure to infringe either required affirmance. The petition does not take issue, either procedurally or substantively, with the Federal Circuit's conclusion that the accused device did not meet the "substantially perpendicular" limitation on the "guide conduit." See Pet. App. 5a. Second, there was no *sua sponte* ruling in this case. The Federal Circuit based its opinion on arguments

made by the parties in that court and in the district court. Third, no mixed issue of law and fact was at issue. As petitioner argued vigorously to the court of appeals, claim construction is a question of law, not a mixed question of law and fact. Petitioner has waived the contrary argument. Fourth, there were no genuine issues of disputed fact relating to the dispositive claim construction and infringement issues here. The court of appeals was entitled to construe that patent based on the undisputed intrinsic record, *i.e.*, the patent claims, specification, and prosecution history.

A. The Judgment Of The Federal Circuit Rests On Alternative And Independent Grounds.

The petition rests on the notion that the Federal Circuit affirmed non-infringement solely because the part of the CD-94 mold alleged to be a "guide conduit" was not formed by "[s]eparating the two mold parts," as Claim 1(d) requires. The petition claims that the Federal Circuit's interpretation of the "separating" limitation was unconstitutionally tainted by consideration of that phrase in context with the "ejecting" limitation in Claim 1(e). See Pet. 11–13.

Any review limited to the "[s]eparating the two mold parts" claim limitation would be advisory, because the Federal Circuit also found that another claim element was not infringed. The court held that the alleged guide conduit in the CD-94 mold did not "lead[] in a direction substantially perpendicular to said predetermined direction." Pet. App. 5a. Based on the undisputed evidence, the court of appeals concluded that "[t]he cavity created by separating the two mold parts in the device used in the accused process only leads in a direction ***parallel*** to the predetermined direction." *Id.* (emphasis in original).

The petition does not contend that ***this*** holding resulted from a *sua sponte* determination, for the good reason that respondents argued the point vigorously in both courts below.

See, *e.g.*, Respondents' C.A. Br. 49-50, 58; Various Defendants' 4/5/2002 Reply Memo 7-8 (district court); Crest's 2/27/2002 Supporting Memo 4-5 (district court). Turn-Key simply failed to persuade those courts that the CD-94 mold had a cavity that led in a perpendicular direction.

That unchallenged holding disposes of this case. A patent claim is infringed only when *all* of its elements are present in the accused product or process. See, *e.g.*, *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997). Because the petition does not challenge the Federal Circuit's conclusion on the "substantially perpendicular" limitation, the judgment of noninfringement could not be disturbed.

Yet "this Court reviews judgments, not opinions." *Chevron U.S.A. Inc.* v. *Natural Resources Defense Council, Inc.*, 467 U.S. 837, 842 (1984). Any inquiry into the process that led to the drafting of non-dispositive aspects of the unpublished opinion in this case would be purely advisory, and beyond this Court's power. See *Preiser* v. *Newkirk*, 422 U.S. 395, 401 (1975). There is nothing for this Court to review.

B. The Federal Circuit Did Not Decide Any Issue *Sua Sponte*.

Turn-Key's due process argument rests on the notion that the Federal Circuit based its opinion on a *sua sponte* claim construction. It did not.

Clearly the court of appeals did not think it was ruling *sua sponte*. The petition (at 10) identifies Judge Bryson as one of the judges of the Federal Circuit who has "disapprove[d] of the practice of *sua sponte* appellate claim construction," yet Judge Bryson joined the unanimous decision in this case and did not dissent from the denial of rehearing even though Turn-Key asserted that "the parties did not brief [the Claim 1(e)] issue on appeal to this Court." C.A. Reh'g Pet. 15.

The Federal Circuit found that two limitations on the "guide conduit" described in Claim 1(d) were missing in the CD-94 mold: (i) that the guide conduit be formed by "[s]eparating the two mold parts"; and (ii) that the guide conduit "lead[] in a direction substantially perpendicular to said predetermined direction." The parties contested both of these points. See, *e.g.*, Respondents' C.A. Br. 37-44, 49-50, 58; Various Defendants' 2/27/2002 Supporting Memo 11-17 (district court).

Turn-Key concedes that the "guide conduit" limitation identified in Claim 1(d) was the focus of the parties' dispute. Pet. 4-5. And Turn-Key does not contend that the plain language of the patent, applied to the undisputed facts, foreclosed the Federal Circuit's conclusion that "[t]he cavity created by the separation of the mold parts [in the accused device] is not a guide conduit." Pet. App. 5a. Rather, the petition challenges only the court's fleeting reference to the ejection step in Claim 1(e) while interpreting the guide conduit limitation, as if that reference turned the focus away from Claim 1(d). That reference cannot bear the weight placed on it.

The Federal Circuit stated its holding clearly: "the CD-94 mold still does not have a ***guide conduit*** as defined by the claims." Pet. App. 5a (emphasis added). The court repeated that characterization of its holding in the very next sentence of its opinion, and confirmed it in nearly identical terms at the end of the relevant discussion. *Ibid.* ("use of the CD-94 mold does not involve a guide conduit"). The Federal Circuit nowhere identified a failure to meet the ejection step in Claim 1(e) as the basis for its holding. Rather, the court of appeals briefly referred to section 1(e) only to confirm that the alleged "guide conduit" in the CD-94 mold was not formed by "[s]eparating the two mold parts" as Claim 1(d) required. *Ibid.* There is nothing improper with this practice. It is axiomatic that a court may look to claim limitations other than the one in dispute to assist in claim construction. *E.g.*, *ACTV, Inc.* v. *Walt Disney*

Co., 346 F.3d 1082, 1088 (Fed. Cir. 2003). As this Court explained, in patents as in other documents, "a term can be defined only in a way that comports with the instrument as a whole." *Markman*, 517 U.S. at 389 (collecting authorities).

Even if the Federal Circuit had found noninfringement *separately* bolstered by the failure to meet Claim 1(e), Turn-Key had its day in court on that secondary issue. Contrary to Turn-Key's contention (at 4 n.3), respondents argued on summary judgment that the ejection step required "that the disc be expelled 'into' a pre-existing guide conduit." Various Defendants' 4/5/2002 Reply Memorandum 14 (district court). As Turn-Key concedes, moreover, this claim element was discussed in the court of appeals both at oral argument and in Turn-Key's petition for rehearing. Pet. 5, 14 n.6. That is enough to satisfy due process.

In fact, the Federal Circuit held that the guide conduit limitation in Claim 1(d) was not infringed even under the court of appeals' broader claim construction. The court's invocation of Claim 1(e) as additional intrinsic evidence to support its conclusion is not *sua sponte* decision-making, but routine legal reasoning to support a conclusion. The petition hinges on a question not presented, and therefore should be denied.

C. Turn-Key Has Correctly Conceded That Claim Construction Is An Issue of Law, Not A Mixed Question Of Fact And Law.

1. Claim Construction Is An Issue Of Law.

Recognizing that there is nothing improper about an appellate court's substituting its own reasoning for that of the parties on a pure question of law such as the interpretation of a statute or written document, Turn-Key argues that this Court "made clear" in *Markman* that claim construction is a mixed issue of fact and law. Pet. 16. That is not so.

In *Markman* this Court held "that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court." 517 U.S. at 372. Although petitioner seizes on a reference to claim construction's "evidentiary underpinnings" (*id.* at 391) to characterize this holding as ambiguous on the fact/law distinction, the Court removed any doubt when it explained the benefits of "treating interpretive issues as *purely legal*." *Ibid.* (emphasis added).

In the face of that clear statement, the Federal Circuit observed that nothing in *Markman* "supports the view that the Court endorsed a silent, third option — that claim construction may involve subsidiary or underlying questions of fact." *Cybor Corp.* v. *FAS Technologies, Inc.*, 138 F.3d 1448, 1455 (Fed. Cir. 1998) (en banc). Turn-Key resorts to wishful thinking when it contends (at 17) that in *Markman* this Court adopted a standard similar to the one for "obviousness" adopted in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966). This Court's *Markman* opinion neither mentioned *Graham* nor suggested any analogy to "obviousness." Rather, this Court made clear that any "any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman*, 517 U.S. at 389. That analysis presents "purely legal" questions. *Id.* at 391.

2. Turn-Key Admitted That Claim Construction Is An Issue Of Law.

Although some parties might have standing to ask that *Markman* be overruled or reinterpreted, Turn-Key is not one of them. Turn-Key stated unequivocally to the Federal Circuit that "[c]laim construction is a matter of law subject to *de novo* review on appeal," and urged the court of appeals to overturn the district court's claim construction using this standard.

Turn-Key C.A. Br. 29. In hopes of intrusive *de novo* review, Turn-Key relied on the very *Cybor* decision that its petition now disparages. Compare *id.* (citing *Cybor*, 138 F.3d at 1454-1456) with Pet. 17-18.

Because Turn-Key's new position that claim construction is a mixed question of fact and law was not "pressed or passed upon below," certiorari is precluded under this Court's "traditional rule." *United States* v. *Williams*, 504 U.S. 36, 41 (1992). See also *id.* at 58 n.3 (collecting cases).

D. There Were No Material Disputed Facts In This Case.

This case would not warrant further review even if the Federal Circuit's passing reference to Claim 1(e) was a separate, *sua sponte* claim construction that resolved a *potentially* mixed issue of fact and law. As the Federal Circuit acknowledged, there were no issues of material fact as to the operation of the CD-94 Mold, so that the infringement could be addressed as a matter of law. Pet. App. 3a. And the court's claim construction relied on the "plain language of the claims" in light of the "written description[] and prosecution history" to the exclusion of extrinsic evidence. *Id.* at 4a. Although Turn-Key maintains that the Federal Circuit "misunderstood the patented method" (Pet. 5), Turn-Key submitted a detailed animation of its view of the patented method to the Federal Circuit and described the patented method in detail, with illustrations, in its briefs. See Turn-Key C.A. Br. 4-11; C.A. App. 708-720; 739.

Nothing in the Federal Circuit's opinion suggests the resolution of a disputed issue of fact, and its resolution of a purely legal issue on appeal does not warrant this Court's attention. That is especially true because the result is assured regardless of further review of the reference to Claim 1(e). See pp. 5–6, *supra.*

II. THE DECISION BELOW DOES NOT CONFLICT WITH ANY DECISION OF THIS COURT OR ANOTHER CIRCUIT.

Turn-Key's effort to manufacture a conflict between the decision below and "numerous court decisions" cannot withstand scrutiny. As explained above, the Federal Circuit's attention to the patent as a whole when construing a contested patent claim limitation was not a *sua sponte* ruling at all.

In any event, the petition concedes that this Court has specifically endorsed the practice of issuing *sua sponte* rulings when a court is considering questions of law. See Pet. 15 (citing, *inter alia*, *Kamen* v. *Kemper Fin. Servs., Inc.*, 500 U.S. 90, 99 (1991)). As a purely legal issue, *Markman*, 517 U.S. at 390, claim construction falls under this principle. By contrast, only the thinnest of "analog[ie]s" (Pet. 13) could connect this case and *Nelson* v. *Adams USA, Inc.*, 529 U.S. 460 (2000). The deprivation of due process in *Nelson* arose from the instantaneous *post*-judgment addition of an individual defendant to a *judgment* of liability against a corporation. The individual had no opportunity to answer and was adjudged liable immediately when leave was granted to amend the complaint retroactively—without so much as the filing of an amended pleading. *Id.* at 463-64. Here, Turn-Key had ample opportunity to advance its patent infringement claims, including its views on the various subparts of the "guide conduit" limitation.

There also is no conflict with decisions from other circuits. None of the cited cases holds that an appellate court violates due process by determining an issue of law that has been briefed simply because the precise contours of its determination do not slavishly follow the position of one or another party.

Indeed, none of the court of appeals decisions cited in the petition has any bearing on the challenged issue of appellate

decision-making.[2] Many criticized a district court's *sua sponte* dismissal of a plaintiff's complaint without notice or a hearing. *Clorox Co.* v. *Procter & Gamble Commercial Co.*, 228 F.3d 24, 30-31 (1st Cir. 2000); *Snider* v. *Melindez*, 199 F.3d 108, 113-114 (2d Cir. 1999); *Shockley* v. *Jones*, 823 F.2d 1068, 1073 (7th Cir. 1987); *Franklin* v. *Oregon State Welfare Div.*, 662 F.2d 1337, 1341-1342 (9th Cir. 1981). Another decision vacated a district court's award—*sua sponte* and without an evidentiary hearing—of money damages that the plaintiff had not even requested. *In re Arthur Treacher's Franchisee Litigation*, 689 F.2d 1137, 1148 (3d Cir. 1982). The Federal Circuit did not dismiss Turn-Key's complaint *sua sponte* without notice or grant unrequested relief to respondents. The court of appeals merely invoked an additional, purely legal reason to support its ruling on an issue that had been fully briefed on appeal.

Some cited decisions not only involve far different factual settings, but weigh against Turn-Key's contention that judicial augmentation of parties' arguments is unconstitutional. For example, then-Judge Scalia noted that a court of appeals was "*not* precluded from supplementing the contentions of counsel through our own deliberations and research," though the D.C. Circuit declined to do so in *Carducci* v. *Regan*, 714 F.2d 171, 177 (D.C. Cir. 1983) (emphasis added). And Judge Posner noted in *Hartmann* v. *Prudential Ins. Co.*, 9 F.3d 1207, 1215

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[2] Petitioner's contention that *sua sponte* decision-making is a widespread problem raising controversy and conflicts within the Federal Circuit is belied by the joinder in the opinion below of Judge Bryson, one of the few identified critics of the supposed *sua sponte* practice. See p. 6, *supra*. Petitioner's failure to seek rehearing en banc to resolve the asserted intra-circuit conflict (see Pet. 7-11,18 n. 8) underscores the soundness of the policy that such conflicts are matters for resolution by the court of appeals, not this Court. See *Wisniewski* v. *United States*, 353 U.S. 901, 902 (1957).

(7th Cir. 1993), that courts "sometimes relieve parties from the consequences of their waivers," but (over a dissent) the Seventh Circuit also declined to do so in that case because the party explicitly *disclaimed* the theory approved in dicta by the court.

Most of the remaining decisions involve a district court's grant of summary judgment *sua sponte* without any notice to the parties that summary judgment was at issue. *Mannesman Demag Corp.* v. *M/V Concert Express*, 225 F.3d 587, 595 (5th Cir. 2000); *Massey* v. *Congress Life Ins. Co.*, 116 F.3d 1414, 1417 (11th Cir. 1997); *Otis Elevator Co.* v. *George Washington Hotel Corp.*, 27 F.3d 903, 910 (3d Cir. 1994). In finding the district court's *sua sponte* grant of summary judgment improper, the court in *Bendet* v. *Sandoz Pharmaceuticals Corp.*, 308 F.3d 907, 912 (8th Cir. 2002), further invoked "the unique facts of th[at] unusually configured case" to find that plaintiff had never received a "clear opportunity to present" causation evidence. None of these cases addresses an appellate court's affirmance of summary judgment under slightly different reasoning.

Bearing equally little on the decision below is *Stoyanov* v. *INS*, 172 F.3d 731, 735 (9th Cir. 1999). In that case, the Ninth Circuit found that the Board of Immigration Appeals violated due process by reversing a grant of asylum based on the Board's *sua sponte* factual finding that the petitioner lacked *credibility*. But neither credibility nor any other factual issue figured in the decision in this case. Rather, both courts below found no need to resort to *any* extrinsic evidence, such as expert testimony, in order to construe the patent claims.[3]

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[3] The asserted "conflict" with various state court decisions (Pet. 21-23) is concededly still "more general[]" — *i.e.*, less distinct — than the non-existent "conflict" with the decisions of other circuits, not least because the state courts did not invoke the U.S. Constitution.

Because there is no conflict among the circuits, the unpublished decision below does not warrant further review.

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted.

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